

Serial No. 10/052,828  
Morgan et al  
Case No. CE08491R

## REMARKS

### REAL PARTY IN INTEREST

The present application is wholly assigned to Motorola, Inc., a Delaware corporation with its headquarters in Schaumburg, Illinois.

### STATUS OF THE CLAIMS

Applicants originally filed claims 1-37 of the present application on October 25, 2001. In the Office Action dated August 20, 2004, claims 1-5, 11-16, 19-23 and 29-35 were rejected under 35 U.S.C. § 102(a) as being anticipated by Applicants' admitted prior art, claims 7, 9-10, 18, 25, 27-28 and 37 were rejected under 35 U.S.C. § 103(a) over Applicants' admitted prior art in view of United States Patent No. 6,108,550 to Wiorek et al., and claims 8, 17, 26 and 35 under Section 103(a) over Applicants' admitted prior art in view of United States Patent No. 6,011,960 to Yamada et al. Applicants responded in a communication mailed November 10, 2004 by amending claims 1 and 19 and canceling claims 3 and 21. In the Final Office Action dated April 14, 2005, claims 2, 4-6 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter with Applicants regards as the invention, claims 1, 2, 4-5, 11-16, 19-20, 22-23, and 29-35 were rejected under 35 U.S.C. § 102(a) as being anticipated by Applicants' admitted prior art, claims 7, 9-10, 18, 25, 27-28 and 37 were rejected under 35 U.S.C. § 103(a) over Applicants' admitted prior art in view of United States Patent No. 6,108,550 to Wiorek et al., and claims 8, 17, 26 and 35 under Section 103(a) over Applicants' admitted prior art in view of United States Patent No. 6,011,960 to Yamada et al. This rejection was made final. Applicant's response to the April 1, 2005 Final Office Action is hereby submitted.

### STATUS OF THE AMENDMENTS

Pursuant to Applicant's amendments made on November 10, 2004 and in this After Final Amendment, claims 1-2, 4-20, 22-37 are currently pending. In this After

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Final Amendment, Applicants amend claims 2 and 4-6 in response to the rejection under Section 112, second paragraph.

#### **SUMMARY OF THE INVENTION**

The present invention relates to a method and an apparatus for enabling a discontinuous transmission feature on a mobile station. As is known, a mobile station communicates with a base station via a reverse link. The mobile station controls transmission via a first communication resource of the reverse link in response to a trigger event. In particular, the mobile information may be, but is not limited to, control information and traffic information. The trigger event may be, but is not limited to, a user-selectable input, a call setup of a telephone number, a busy tone associated with a dialed telephone number, and a voice input. The mobile station may terminate transmission of mobile information via the first communication resource such as a reverse fundamental channel and a reverse traffic channel. Further, the mobile station may transfer control information from the first communication resource over to a second communication resource for transmission to the base station. Accordingly, the mobile station transmits control information via the second communication resource such as a reverse dedicated control channel to the base station.

In particular, the reverse link includes a plurality of communications resources, such as, but not limited to, a reverse pilot channel, a reverse fundamental channel, and a reverse dedicated control channel. Each of these plurality of communication resources is operable for different functions. For example, the reverse fundamental channel may be operable for transmission of traffic information such as encoded audio and data information. The reverse dedicated control channel may be operable for discontinuous transmission. To reduce interference within the communication system and to conserve power, the mobile station may be operable for discontinuous transmission when encoded audio and data information is not necessary on the reverse link. In such a case, the mobile station is adapted in accordance with principles of the present invention to enable the discontinuous transmission feature and discontinue the use of the continuous transmission.

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A user input device on the mobile unit, sets up the discontinuous transmission feature by way of a trigger event, such as a touch of the keypad or calling a designated telephone number. Moreover, the mobile unit controls the transmission of mobile information via the a first communication resource of the reverse link. Such control may include terminating, or ending, transmission of mobile information via the first communication resource such as the reverse fundamental channel and a reverse traffic channel.

#### **GROUND OF THE REJCTIONS TO BE REVIEWED**

1. Claims 2, 4-6 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter with Applicants regards as the invention.

2. Claims 1, 2, 4-5, 11-16, 19-20, 22-23, and 29-35 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Applicants' admitted prior art.

3. Claims 7, 9-10, 18, 25, 27-28 and 37 stand rejected under 35 U.S.C. § 103(a) over Applicants' admitted prior art in view of United States Patent No. 6,108,550 to Wiorek et al.

4. Claims 8, 17, 26 and 35 stand rejected under Section 103(a) over Applicants' admitted prior art in view of United States Patent No. 6,011,960 to Yamada et al.

#### **ARGUMENTS**

Reconsideration of the above-referenced application is respectively requested in view of the above amendments and these remarks.

In the Final Office Action, claims 2 and 4-6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with Applicants regards as the invention. Applicant has amended claims 2 and 4-6 by deleting the term "controlling" for which there was no antecedent basis and inserting the term "terminating," which is found in claim 1 upon which claims 2 and 4-6 depend. As each and every limitation in claims 2 and 4-6 have the necessary antecedent basis, Applicant respectfully submits that the rejected claims

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particularly point out and distinctly claim the subject matter that Applicants regards as the invention. It is therefore respectfully requested that the rejection under Section 112, second paragraph, be withdrawn.

Claims 1, 2, 4-5, 11-16, 19-20, 22-23, and 29-35 were rejected under 35 U.S.C. § 102(a) as being anticipated by Applicants' admitted prior art. In the Office Action, it is stated that the Specification on page 1, line 23 to page 2, line 10 discloses the present invention as provided in claims 1, 11, 19, and 29-30. Moreover, it is stated that "terminate" is taken to mean either (i) stop transmission or (ii) direct a phone call to its destination such that "terminating a transmission in response to a trigger event" could be direct a phone call to a called party when a calling party dials the number of the called party. Applicant respectfully traverses this rejection based on the totality of the circumstances and a complete reading of the Specification.

"Claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." *United States v. Adams*, 383 U.S. 39, 178 USPQ 479 (1966). "[T]he specification aids in ascertaining the scope and meaning of the language employed in the claims inasmuch as words must be used in the same way in both the claims and the specification." *Autogiro Co. of America v. United States*, 384 F.2d 391, 155 USPQ 697 (Ct. Cl. 1967). "The use of the specification as a concordance for the claim is accepted by almost every court, and is a basic concept of patent law." 384 F.2d at 397-98, 155 USPQ at 702-03. In the in banc decision, *Markman v. Westview Instruments, Inc.* (1995), the Federal Circuit reconfirmed the specification's importance in interpreting claims:

"Claims must be read in view of the specification, of which they are a part. ... The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. ... As we have often stated, a patentee is free to be his own lexicographer." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) (in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996).

As is known, Applicants are allowed to their own lexicographer, *see* MPEP 2171. Applicants have provided sufficient details to define "terminating" or "terminate" to

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mean stop transmission instead of directing a phone call to its destination. As stated above, the present invention is directed to reducing interference and power consumption by using discontinuous communications when possible. When a trigger event occurs, such as a use-selectable input, dialing of a particular telephone number, a busy tone associated with a telephone number, and a voice input, use of the reverse fundamental channel or reverse traffic channel is terminated or stopped. Support for this is found on page 4, lines 7-13 that describes how the transmission is terminated for the reverse fundamental channel or reverse traffic channel, which make up the first communication resource, and transferred to the second transmission resource, i.e. the reverse dedicated channel, so that control information is transmitted over the second transmission resource instead of the first transmission resource. The combination of "terminating" transmission on one channel and then transferring the transmission to another channel explicitly suggests stopping transmission on the first channel because one needs to stop transmission on the first channel in order to transfer it to another. No suggestion is made to another alternative to terminate before transfer. Language similar to what is discussed is found on page 4 is found on page 7, line 14 to page 8, line 14

Moreover, on page 6, lines 7-22, the Specification states that discontinuous transmission is used to conserve power, and then a reverse link is not used to transmit encoded audio data. As stated, "traffic information (e.g. encoded audio information) is transmitted from the base station 140 to the mobile station 160 via the forward link 220 without transmission of encoded audio information from the mobile station 160 via the reverse link 120." Thus, the reverse link channels that provide for that audio transmission, e.g. in the first communication resource, is not needed and transmission over that resource is stopped and terminated. If the alternative meaning of "terminating" and "terminate" is considered in this context, it does not logically follow that no audio would flow after the phone call is directed to its destination.

The ordinary and customary use of the "terminating" and "terminate" are consistent with Applicants' use of the term to mean stop transmission. *Merriam Webster's Collegiate Dictionary, Tenth Addition*, Merriam-Webster, Incorporated, 1993, defines terminate as "1a: to bring to an end: CLOSE b: to form the conclusion of . . . c: to discontinue . . . ." Each of these definitions is consistent with Applicants' use of the

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term. The present invention "brings to an end, closes," "forms the conclusion of," and "discontinues" the use of the first communication resource and uses the second transmission resource for discontinuous transmission.

Furthermore, Applicant does not use or refer to "terminating" or "terminate" on page 1, line 23 to page 2, line 10. In fact, that portion of the Specification establishes the myriad of functions that the reverse link can serve in the connection made between a mobile station and a base station. No where within the Specification do Applicants discuss or be concerned with the establishment of a connection between the mobile station and the base station. Without this description and because the invention, as defined in the Specification, does not relate to the "[directing] a phone call to its destination, it is unreasonable to have "terminating" or "terminate" to have this definition within the claims.

To summarize, Applicants use "terminating" or "terminate" to mean stop transmission for at least three reasons. First, the Specification makes clear that the audio control data is not used on the first transmission channel of the reverse link. Second, the ordinary and customary usage of the term is consistent with the Applicants description in the Specification. Finally, Applicants do not rely on the use of the "terminating" or "terminate" to mean the alternative meaning of directing a call to a destination. In view of this, Applicant respectfully submits that claims 1, 11, 19, and 29-30 are not anticipated under 35 U.S.C. § 102(a) by Applicants' admitted prior art. As claims 2, 4-5, 12-16, 20, 22-23 and 31-35 depend upon independent claims 1, 11, 19 and 30 and include each and every limitation of the independent claims, it is respectfully submitted that those dependent claims are also not anticipated under 35 U.S.C. § 102(a) by Applicants' admitted prior art. It is therefore respectfully requested that the rejection under Section 102(a) be withdrawn.

In the Final Office Action, claims 7, 9-10, 18, 25, 27-28, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art in view of United States Patent No. 6,108,550 to Wiorek et al. In addition, claims 8, 17, 26, and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art in view of United States Patent No. 6,011,960 to Yamada et al. Neither Wiorek nor Yamada supply the necessary teaching regarding termination of transmission

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of mobile information in response to a trigger event. Wiorek and Yamada also do not use the "terminating" or "terminate" in the context as described above. Thus, no combination of Wiorek, Yamada and Applicants' admitted prior art teach or otherwise suggest all the limitations found in claims 7-10, 17-18, 25-28 and 36-37. It is therefore respectfully requested that the rejections under Section 103(a) be withdrawn.

As the Applicants have overcome all substantive rejections and objections given by the Examiner and have complied with all requests properly presented by the Examiner, the Applicants contend that this Amendment, with the above discussion, overcomes the Examiner's objections to and rejections of the pending claims. Therefore, the Applicants respectfully solicit allowance of the application. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this response, the Examiner is invited to contact the undersigned representative to expedite resolution of the matter.

Please charge any fees associated herewith, including extension of time fees, to 50-2117.

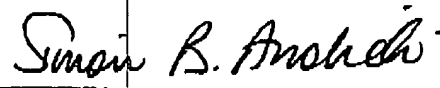
Respectfully submitted,  
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